



02-20-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #71

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TTAB  
Exhibits

Kevin T. McCarney, dba Poquito Mas,

Opposer,

v.

Una Mas, Inc.,

Applicant.

Opposition Nos. 107,026  
and 107,748

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed  
enclosures, is being deposited with the United States  
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FEE, Assistant Commissioner for Trademarks, 2900  
Crystal Drive, Arlington, VA 22202-3513

Date:

2-14-02

Signed:

Christine P. Peters

Christine P. Peters

Attn.: TTAB -- No Fee  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**APPLICANT'S MEMORANDUM IN OPPOSITION TO  
OPPOSER'S MOTION TO STRIKE APPLICANT'S RESPONSES  
TO OPPOSER'S REQUEST FOR ADMISSIONS  
OR IN THE ALTERNATIVE  
APPLICANTS MOTION TO AMEND ADMISSIONS PURSUANT TO FRCP 36(b)**

Applicant, Una Mas Restaurants, Inc., hereby opposes Opposer, Kevin T. McCarney's  
MOTION TO STRIKE APPLICANT'S UNTIMELY RESPONSES TO OPPOSER'S FIRST  
SET OF REQUESTS FOR ADMISSIONS, on the grounds that Applicant's Responses to  
Opposer's First Set of Requests for Admissions were timely served. In the alternative, Applicant  
requests that this Board find that Applicant's allegedly untimely responses were the result of  
excusable neglect.

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### **FACTS**

1. On March 27, 1998, this Board suspended this proceeding until September 27, 1998, on the grounds that the parties were negotiating a possible settlement of this case.
2. On June 1, 1998, Opposer served its First Request for Interrogatories, First Request for Production of Documents, and First Request for Admissions (collectively "the Discovery Requests"). Declaration of Christine Peters, ¶ 2.
3. On June 22, 1998, Applicant sent a letter to Opposer, stating that the Discovery Requests were not timely and required no response, as the requests were served while the proceeding was suspended. Peters Declaration, ¶ 3.
4. On September 30, 1998, Opposer concurrently filed his Motion for Summary Judgment and Motion to Suspend. Opposer's Motion to Suspend asked this Board to suspend any further proceeding and the stay of all trial dated until resolution of Opposer's Summary Judgement Motion is reached.
5. On November 24, 1998, this Board issued an order suspending this proceeding pending disposition of Opposer's Motion for Summary Judgment.
6. On August 13, 1999, this Board suspended the proceedings for six months because the parties were negotiating a possible settlement of this case.
7. On July 14, 2000, this Board resumed the proceedings in response to Opposer's Request for Status. This Board allowed Applicant forty days from date of mailing to file a Response to Opposer's Motion for Summary Judgment.

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8. On November 09, 2001, this Board denied Opposer's Motion for Summary Judgement, as well as Applicant's Cross Motion for Summary Judgment, and reset the Trial Dates in this matter. Per this Board's order, the close of Discovery was set for February 01, 2002.

9. In a letter dated January 10, 2002, Opposer demanded that Applicant respond to his Request for Interrogatories and Request for Production of Documents by January 20, 2002, but did not mention his Requests for Admissions. Peters Declaration, ¶ 4 .

10. In a letter dated January 18, 2002, Applicant responded that it would serve its Responses to the Interrogatories and Document Requests by January 22, 2002. Peters Declaration, ¶ 5.

11. Applicant served its Responses to Opposer's Request for Interrogatories and Written Responses to Opposer's Request for Production of Documents on January 22, 2002. Peters Declaration, ¶ 6, 7.

12. Applicant served its Responses to Opposer's Request for Admissions on January 24, 2002. Peters Declaration, ¶ 8.

## **ARGUMENT**

### **I. APPLICANT'S RESPONSES TO ADMISSIONS WERE NOT UNTIMELY**

On March 27, 1998, this Board suspended this proceeding until September 27, 1998, on the grounds that the parties were negotiating a possible settlement of this case. Despite the suspended status of the proceedings, Opposer served its First Request for Interrogatories, First

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Request for Production of Documents, and First Request for Admissions on June 1, 1998 ("the Discovery Requests"). Declaration of Christine Peters, ¶ 2. Opposer's service of its Discovery Requests were therefore improper. *See, Orion Group, Inc. v. The Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1924, n.3 (discovery activity after proceedings suspended was improper until allowed by Board.).

On June 22, 1998, Applicant notified Opposer that the Discovery Requests were not timely and required no response, as the requests were served while the proceeding was suspended. Peters Declaration, ¶ 3. Opposer, however, did not respond to the letter, and never re-served the Discovery Requests. Thereafter, Opposer filed its Motion for Summary Judgment, concurrently with a Motion to Suspend Proceedings pending the resolution of Opposer's Summary Judgement Motion. This proceeding remained suspended until November 09, 2001, when this Board denied Opposer's Motion for Summary Judgement, as well as Applicant's Cross Motion for Summary Judgment, and reset the Trial Dates in this matter.

Instead of properly re-serving the Discovery Requests, Opposer's counsel sent a letter dated January 10, 2002, in which Opposer demanded that Applicant respond to his Request for Interrogatories and Request for Production of Documents. Peters Declaration, ¶ 4. The letter did not mention Opposer's Request for Admissions. In the spirit of cooperation, Applicant treated the January 10, 2002 letter from Opposer's counsel as the renewed service of the Discovery Requests. Accordingly, Applicant served its Responses to Opposer's Request for Interrogatories and Written Responses to Opposer's Request for Production of Documents on January 22, 2002,

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and its Responses to Opposer's Request for Admissions on January 24, 2002. Peters Declaration, ¶ 6-8.

Opposer's initial service of the Discovery Requests was improper, as it occurred while this proceeding was suspended, and were never re-served during a time allowed by this Board. Viewed most favorably to Opposer, at most its Interrogatories and Documents Requests were re-served by mail on January 10, 2002, making Applicant's responses due on February 14, 2002. Opposer, however, never served its Request for Admissions during a period allowed by this Board. Nor did it notify applicant of a request for responses to such requests. Accordingly, Applicant's Responses to Opposer's Request for Admissions were not untimely, and Opposer's Motion to Strike should be denied.

**II. ASSUMING THE BOARD FINDS THAT SUCH REQUESTS FOR ADMISSIONS WERE TIMELY SERVED, APPLICANT'S ALLEGEDLY UNTIMELY RESPONSES WOULD BE EXCUSABLE.**

Alternatively, if this Board should find that Opposer's Request for Admissions were properly served, Applicant asserts that its alleged failure to timely respond to the requests Would be the result of excusable neglect pursuant to Fed. R. Civ. P. 6(b). In *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), this Board found that the determination as to whether a party's neglect is excusable is an equitable one, taking account of all relevant circumstances surrounding the party's omission, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the

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movant acted in good faith. (citing *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership et al.*, 507 U.S. 380, 395 (1993).)

Here, Opposer's Request for Admissions were served while this proceeding was suspended. Thereafter, this proceeding was repeatedly suspended pending the disposition of Opposer's Motion for Summary Judgment. Accordingly, it was not clear to Applicant whether Opposer's discovery requests were properly served, and when they were due pending the suspension of the proceeding. Additionally, Applicant acted in good faith by serving its responses to Opposer's Interrogatories and document Requests after Opposer sent a letter stating they were due, instead of forcing Opposer to again serve them. Opposer did not mention such Requests for Admissions in its letter.

Furthermore, relieving Applicant of the consequences of its allegedly untimely responses will not prejudice Opposer, and will not result in a lengthy delay of these proceedings. Opposer's testimony period does not open until April 2, 2002. Therefore, Opposer can be relieved of any possible prejudice by extending the discovery period. *See, Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.*, 14 USPQ2d 2064, 2065 (TTAB1990) (any possible prejudice to propounding party can be overcome by extending the discovery period.). Furthermore, any limited re-opening of discovery related to Applicant's Responses to Request for Admissions should not create a lengthy delay in this proceeding.

### CONCLUSION

Thus, for the above reasons, Applicant requests that this Board deny Opposer's MOTION

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TO STRIKE APPLICANT'S UNTIMELY RESPONSES TO OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSIONS, on the grounds that Opposer's discovery requests were improperly served, and therefore Applicant's responses were not untimely. In the Alternative, if the Board finds that Opposer's Request for Admissions were properly served, Applicant requests that this Board find that Applicant's allegedly untimely responses be entered because they would be the result of excusable neglect, and non-prejudicial to Opposer.

Respectfully submitted,

FLEHR HOHBACH TEST  
ALBRITTON & HERBERT LLP

Date: 2/14/02

By David J. Brezner  
David J. Brezner  
Attorney for Applicant

Four Embarcadero Center, Suite 3400  
San Francisco, CA 94111  
(415) 781-1989  
#1074399

CERTIFICATE OF SERVICE BY MAIL

I, Christine P. Peters, certify and declare as follows:

I am over the age of 18, and not a party to this action. My business address is Flehr Hohbach Test Albritton & Herbert LLP, Four Embarcadero Center, Suite 3400, San Francisco, California 94111.

I am readily familiar with the business practice at my place of business for collection and processing of correspondence for mailing with the United States Postal Service. Correspondence so collected and processed is deposited with the United States Postal Service that same day in the ordinary course of business.

On February 14, 2002, at my place of business at San Francisco, California, a copy of the following document:

**APPLICANT'S MEMORANDUM IN OPPOSITION TO  
OPPOSER'S MOTION TO STRIKE APPLICANT'S RESPONSES  
TO OPPOSER'S REQUEST FOR ADMISSIONS  
OR IN THE ALTERNATIVE  
APPLICANTS MOTION TO AMEND ADMISSIONS PURSUANT TO FRCP 36(b)**

was placed for deposit in the United States Postal Service in a sealed envelope, with postage fully prepaid, addressed to:

Robert V. Vickers  
Vickers, Daniels & Young  
50 Public Square, Suite 2000  
Cleveland, OH 44113

Attorney for Opposer

and such envelope was placed for collection and mailing on February 14, 2002 following ordinary business practices.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on February 14, 2002 at San Francisco, California.

  
Christine P. Peters





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Date:

2-14-02

Signed:

*Christine P. Peters*

Christine P. Peters

Attn.: TTAB -- No Fee  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**DECLARATION OF CHRISTINE P. PETERS  
IN SUPPORT OF APPLICANTS MEMORANDUM IN OPPOSITION TO OPPOSER'S  
MOTION TO STRIKE APPLICANT'S RESPONSES TO OPPOSER'S FIRST REQUEST  
FOR ADMISSIONS OR IN THE ALTERNATIVE APPLICANT'S MOTION TO AMEND  
ADMISSIONS PURSUANT TO FRCP 36(b)**

1. I am a paralegal with the law firm of FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP, Four Embarcadero Center, Ste. 3400, San Francisco, CA 94111. Except as otherwise stated, I make this declaration of my own personal knowledge. If called as a witness, I could and would testify competently to the facts set forth herein.

2. Attached as Exhibit 1 is a true and correct copy of Opposer's First Request for Admissions to Applicant, served on June 01, 1998.

3. Attached as Exhibit 2 is a true and correct copy of a letter dated June 22, 1998, sent by David J. Brezner to Robert V. Vickers.

4. Attached as Exhibit 3 is a true and correct copy of a letter dated January 10, 2002, sent by Robert V. Vickers to David J. Brezner.

5. Attached as Exhibit 4 is a true and correct copy of a letter dated January 18, 2002, sent by David J. Brezner to Robert V. Vickers.

6. Attached as Exhibit 5 is a true and correct copy of Applicant's responses to Opposer's First Set of Interrogatories, served on January 22, 2002.

7. Attached as Exhibit 6 is a true and correct copy of Applicant's responses to Opposer's First Request for Production of Documents, served on January 22, 2002.

8. Attached as Exhibit 7 is a true and correct copy of Applicant's responses to Opposer's First Request for Admissions, served on January 24, 2002.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Respectfully submitted,  
FLEHR HOHBACH TEST  
ALBRITTON & HERBERT LLP

Dated: 2-14-02

By Christine P. Peters  
Christine P. Peters

Four Embarcadero Center  
Suite 3400  
San Francisco, CA 94111  
(415) 781-1989  
1074556

CERTIFICATE OF SERVICE BY MAIL

I, Christine P. Peters, certify and declare as follows:

I am over the age of 18, and not a party to this action. My business address is Flehr Hohbach Test Albritton & Herbert LLP, Four Embarcadero Center, Suite 3400, San Francisco, California 94111.

I am readily familiar with the business practice at my place of business for collection and processing of correspondence for mailing with the United States Postal Service. Correspondence so collected and processed is deposited with the United States Postal Service that same day in the ordinary course of business.

On February 14, 2002, at my place of business at San Francisco, California, a copy of the following document:

**DECLARATION OF CHRISTINE P. PETERS IN SUPPORT OF APPLICANT'S  
MEMORANDUM IN OPPOSITION TO  
OPPOSER'S MOTION TO STRIKE APPLICANT'S RESPONSES  
TO OPPOSER'S REQUEST FOR ADMISSIONS  
OR IN THE ALTERNATIVE  
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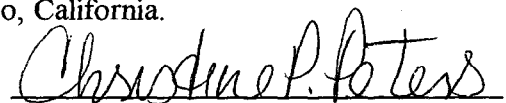
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Vickers, Daniels & Young  
50 Public Square, Suite 2000  
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Attorney for Opposer

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I declare under penalty of perjury that the foregoing is true and correct.

Executed on February 14, 2002 at San Francisco, California.

  
Christine P. Peters